



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,385	02/01/2002	Jacqui Gates	1076.41118X00	8435
20457	7590	04/06/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			DAO, MINH D	
			ART UNIT	PAPER NUMBER
			2682	8

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,385

Applicant(s)

GATES, JACQUI

Examiner

MINH D DAO

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6.7</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "the mobile telephone" in line 1. There is insufficient antecedent basis for this limitation in the claim. In the following art rejection, the examiner rejects claim 9 with his best understanding that "the mobile telephone" refers to "the mobile telecommunications device" of claim 1.

1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the claim depends on itself. It is unclear if this claim should depend on claim 3 since the claim recites the limitation set forth in claim 3. In the following art rejection, the examiner rejects claim 4 with his best understanding.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

~~A person shall be entitled to a patent unless -~~

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,5,9,10,12,13,15,16,18,19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamada et al. (US Patent 6,192,258).

Regarding claim 1, Kamada teaches a method of controlling a mobile telecommunications device (see fig. 1A, item 100) including a memory (see fig. 2, items 105,107,108) for storing a list of contacts each having an e-mail address (see fig. 7) associated therewith and a keypad (see fig. 1A, item 131) including a short-cut key (item 132), the method comprising the steps of: a) accessing the list of contacts stored in the memory (see fig. 7); b) selecting a contact from said list (see fig. 10; col. 8, lines 56-67; col. 9, lines 1-11); c) accessing a screen for composing an e-mail message having a recipient address field by activating the short-cut key, wherein activation of said key also enters the e-mail address of said selected contact in the recipient address field; d) composing an e-mail message; and e) activating a key to send said message to the address entered in the recipient address field (see fig. 10; col. 8, lines 56-67; col. 9, lines 1-11).

Regarding claim 2, the claim has the limitations that are included in limitations of claim 1 and therefore is rejected for the same reason set forth in claim 1.

Regarding claim 5, the claim has the limitations that are included in limitations of claim 1 and therefore is rejected for the same reason set forth in claim 1.

Regarding claim 9, the claim has the limitations that are included in limitations of claim 1 and therefore is rejected for the same reason set forth in claim 1.

Regarding claims 10 and 13, Kamada teaches a method according to claim 1, wherein each contact has a telephone number (see figs. 7 and 10) and/or a URL address associated therewith in addition to the e-mail address (see figs. 7 and 10), the short cut key being operable to either access a screen for composing an e-mail message, access a screen for composing a text message (see fig. 10, item 1006) or connect to the URL address in dependence on a default programming option selected by the user.

Regarding claims 16 and 18, Kamada teaches a method according to claims 1, wherein each contact has a telephone number and/or a URL address associated therewith in addition to an e-mail address (see figs. 7 and fig. 10), a different short cut key being operable to access a screen for composing an e-mail, access a screen for composing a text message and to connect to the URL address (col. 11, lines 27-31).

~~Regarding claim 19, the claim has the limitations that are included in limitations of claim 1 and therefore is rejected for the same reason set forth in claim 1.~~

Regarding claim 20, Kamada teaches computer program stored in a memory and configured to be run by a controller (see fig. 4, item 460) to perform the method steps according to claim 1.

Regarding claims 12 and 15, Kamada teaches a method according to claim 5, wherein each contact has an e-mail address and/or a telephone number associated therewith in addition to the URL address, the short cut key being operable to connect to the URL address, access a screen for composing a text message or access a screen for composing an e-mail in dependence on a default programming option selected by the user (col. 11, lines 27-31).

4. Claims 3,4,6,11,14,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (US Patent 5,923,327).

Regarding claim 3, Smith teaches a method of controlling a mobile telephone (see fig. 2; col. 4, lines 32-37), including a memory (col. 5, lines 58-64) for storing a list of contacts each having a telephone number (col. 6, lines 47-57) associated therewith and a keypad including a short cut key (see fig. 3, item 330; col. 7, lines 15-23), the method including the steps of: a) accessing the list of contacts stored in the memory (col. 7,

~~lines 15-23); b) selecting a contact from the list (col. 7, lines 24-33); c) activating the~~
short cut key to access a screen for composing a text message (SMS) having a field for entry of the recipients telephone number (col. 11, lines 10-19) and/or name, wherein activation of said short cut key also enters the selected telephone number and/or name of the selected contact in the telephone number and/or name field; d) composing a text message (SMS) (col. 4, lines 54-64); and e) activating a key to send said message to the selected telephone number and/or name in the telephone number and/or name field (col. 9, lines 12-22).

Regarding claim 4, the claim has the limitations that are included in limitations of claim 3 and therefore is rejected for the same reason set forth in claim 3.

Regarding claim 6, the claim has the limitations that are included in limitations of claim 4 and therefore is rejected for the same reason set forth in claim 4.

Regarding claims 11 and 14, Smith teaches a method according to claim 3, wherein each contact has an e-mail address and/or a URL address associated therewith in addition to a telephone number (see fig. 6), the short cut key being operable to access a screen for composing an e-mail, access a screen for composing a text message (col. 4, lines 54-64) or connect to the URL in dependence on the duration of time that the short cut key is depressed.

Art Unit: 2682

Regarding claim 17, Smith teaches a method according to claim 3 wherein each contact has an e-mail address (see fig. 6) and/or a URL address associated therewith in addition to a telephone number (see fig. 6), a different short cut (col. 9, lines 34-40) key being operable to access a screen for composing an e-mail address, for composing a text message and for connecting to the URL address.

5. Claims 7,8, are rejected under 35 U.S.C. 102(e) as being anticipated by Boys (US Patent 6,314,094).

Regarding claim 7, Boys teaches method of controlling a mobile telephone (see fig. 2, item 43) including a memory (see fig. 3, item 73, Cache Memory) for storing a list of contacts each having a URL address (col. 8, lines 24-30) associated therewith and a keypad including a short-cut key (see fig. 2, item 51), the method comprising the steps of: a) accessing the list of contacts stored in the memory (see fig. 6, step 123); b) selecting a contact from said list (see fig. 6, step 125); c) connecting to the URL by activating the short-cut key (see fig. 6, step 127).

Regarding claim 8, the claim has the limitations that are included in limitations of claim 7 and therefore is rejected for the same reason set forth in claim 7.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Johnson (US 6,005,928) discloses Method And System For Automatic Distribution Addressing.
- b. Rossmann (US 5,809,415) discloses Method And Architecture For An Interactive Two-Way Data Communication Network.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2682

~~Information regarding the status of an application may be obtained from the~~
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao
Examiner
Art Unit 2682
April 1, 2004 *mdp*


LEE NGUYEN
PRIMARY EXAMINER